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REMARKS

The Applicants wish to thank the Examiner for the careful consideration of the application.

Claims 1 – 5, 9 – 11, 14 – 16, 19, and 20 were in the application. Claims 1 – 3, 5, 9 – 11, 14, and 15 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,031,975 (Iijima). Claims 4, 16, 19, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Iijima in view of U.S. Patent No. 5,911,044 (Lo et al.).

The rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) are respectfully traversed.

THE REJECTIONS UNDER 35 U.S.C. §102(b)**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). [MPEP 2131]

The cited reference relied upon by the Examiner, Iijima, does not set forth each and every element of the rejected claims, either expressly or inherently. Rather, the Examiner has distorted the meaning of what is actually disclosed in Iijima beyond the plain meaning of the terms.

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First, the specification of the present application clearly sets out what is meant by "scanning device":

"Image scanning devices are computer peripheral devices which optically scan an image source (i.e., a photographic image or printed text document) to produce a digital representation of that image. There are a number of different types of scanners including, for example, flat-bed scanners, sheet-fed scanners, photographic image scanners, etc." [page 1, lines 8 – 11, underlining added]

This definition is in accord with common usage, and would not be understood by one "skilled in the art" to include the combination of a scanner AND a "client" host computer. Indeed, scanners are generally understood to be "computer peripheral devices" which are separate, or "peripheral" to a computer, as explicitly stated in the application. The claim element is also explicitly a "device" rather than an "assembly of devices", a "system", a "sub-system", or a "grouping of devices".

The Applicants do not believe that this is mere semantic quibbling, since the type of problem the invention is intended to address involves ease of use or convenience. As stated in the BACKGROUND OF THE INVENTION, "there exists a need for a scanning device that is capable of being shared by a plurality of users and that is relatively easy and convenient to use." This is achieved in part by incorporating functionality into the scanning device to allow the user to easily identify, from the scanning device, the destination of the scan. It is thus an unreasonable distortion of the plain meaning of the term "scanning device" to expand it to include functions performed by a group of devices, including a computer (or a "client"). Such an assembly of devices could conceivably perform a similar function, but clearly it would not be the present invention as claimed, and would not achieve the goals of the present invention.

Further, the Examiner likewise distorts the plain meaning of the claim element "displaying a host identifier (ID) for identifying a host computer" to include displaying the telephone number of the destination of a facsimile transmission. While one could conceivably draw some parallels between the two, the plain

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meaning of "identifying a host computer" is very clear. Iijima does not expressly or inherently disclose "identifying a host computer"; Iijima discloses something quite different.

Since the cited reference, Iijima, fails to disclose all elements of the claimed invention, the rejections under 35 U.S.C. §102(b) should be withdrawn.

THE REJECTIONS UNDER 35 U.S.C. §103(a)

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [MPEP § 2142]

To establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations. As discussed above, Iijima fails to disclose both a scanning device in the plain meaning of that term, and displaying a host identifier (ID) for identifying a host computer. These limitations are in each of the claims of the application. Further, as discussed in the Amendment filed on October 19, 2005, Lo fails to disclose "wherein the displaying, the receiving, the scanning and the transmitting are performed by the scanning device and not the server", a limitation also in each of the pending claims.

Since the cited references fail to teach or suggest all of the claim elements, the rejections under 35 U.S.C. §103(a) should be withdrawn.

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The Applicants believe that application is now in condition for allowance, and favorable action by the Examiner is respectfully requested.

Respectfully submitted,

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